

## REMARKS

Applicant gratefully acknowledges the indication of allowed claims 14-19 and the allowable subject matter in dependent claims 6, 7, 9, and 11.

Applicant submitted proposed drawing corrections in the reply filed March 5, 2002. These corrections involved relocating the reference arrow indications for reference character "95" in FIGS. 2 and 3 so that the arrows correctly identify the snap ring element. No indication has been provided as to whether these corrections have been approved by the examiner. Another copy of these proposed drawings corrections is enclosed for the examiner's convenience. Applicant respectfully requests approval of these corrections in the next Office action.

Claims 1-5, 8, 10, 12 and 13 stand rejected under 35 USC 103(a) as being unpatentable over U.S. Patent 6,315,435 to Hamilton *et al.* (Hamilton).

Independent claim 1 recites:

A searchlight device comprising:

a housing including a first end;

a window in the first end of said housing;

a lamp disposed within said housing so as to emit light through said window;

a shaft; and,

a positioning assembly secured *within* said housing, said positioning assembly including: a first motor operable to rotate said housing in a first plane with respect to said shaft, and a second motor operable to pivot said housing in a second plane with respect to said shaft.

Hamilton does not teach or suggest "a positioning assembly secured within said housing" as called for in claims 1-5, 8, 10, 12 and 13. Hamilton teaches a searchlight having a

controllable lighthouse 2 which appears to include a lamp disposed in a housing (see Fig. 1 and Figs. 2a and 2b), a first motor 6, a first gearbox 8, a second motor 10, a second gearbox 12 and a control housing 4, all mounted on a common base 14. The lamp, motors and gearboxes are not all mounted in the same housing as claimed.

The examiner states that locating the positioning assembly "within" the housing would have been obvious to one of ordinary skill in the art at the time of invention was made because rearranging parts of an invention involves only routine skill in the art. The applicant respectfully disagrees with this conclusion. The court in *In re Japikse*, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950) held that the relocating an element of a device is not patentable subject matter if such a change does not modify the operation of the device. One of ordinary skill in the art will appreciate from applicant's disclosure that securing the positioning assembly within the housing, as claimed, provides the motors, gears and controller of the positioning assembly with protection from harsh environments. This feature enables the claimed invention to operate in marine applications where the corrosive effects of salt water can be extremely detrimental to the motors, gears and the controller of the positioning assembly. Accordingly, securing the positioning assembly within the housing is more than just a "mere rearrangement of parts."

Furthermore, there is no motivation for modifying Hamilton such that the lamp, motors and gearboxes are all secured within the same housing. The mere fact that one of ordinary skill in the art could rearrange the parts of a prior art device to meet the terms of the claims is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation for one of ordinary skill in the art to rearrange the parts of the prior art device, without the benefit of applicant's specification. *Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984).

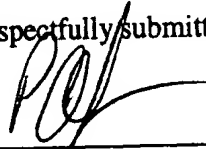
In view of the foregoing, withdrawal of this rejection is respectfully urged.

Applicant submits that the finality of this Office Action is premature because the new rejection presented in this Office Action was not necessitated by a claim amendment made by the applicant nor based on information submitted by applicant in an information disclosure statement (see MPEP 706.07(a) Final Rejection, When Proper on Second Action). Accordingly, applicant respectfully requests the finality of this Office Action be withdrawn.

Favorable reconsideration of this application is respectfully requested as it is believed that all outstanding issues have been addressed herein and, further, that claims 1-19 are in condition for allowance, early notification of which is earnestly solicited. Should there be any questions or other matters whose resolution may be advanced by a telephone call, the Examiner is cordially invited to contact Applicant's undersigned attorney at his number listed below.

No fee is believed to be due as a result of this communication. The Commissioner is hereby authorized to charge any other fees which may be required or credit any overpayment to Deposit Account No. 50-2061.

Respectfully submitted,



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